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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**Docket Number (Optional)  
1316N-001633

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On September 8, 2005

Signature

Typed or printed name Michael J. SchmidtApplication Number  
10/730,560Filed  
12/08/2003First Named Inventor  
Gary W. Groves, et al.Art Unit  
3683Examiner  
Melody M. Burch

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

See Attached

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

See Attached

I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 34,007.

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

  
SignatureMichael J. Schmidt  
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Telephone numberSeptember 8, 2005  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.



**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No.: 10/730,560  
Filing Date: 12/08/2003  
Applicant: Gary W. Groves, et al.  
Group Art Unit: 3683  
Examiner: Melody M. Burch  
Title: SOLENOID ACTUATED CONTINUOUSLY VARIABLE  
SERVO VALVE FOR ADJUSTING DAMPING IN SHOCK  
ABSORBERS AND STRUTS  
Attorney Docket: 1316N-001633

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL REVIEW**

Sir:

The Examiner has rejected Claims 1-11 and 13-21 under 35 USC § 103(a) as being unpatentable over Groves, et al. (USP 6,464,048) in view of Nezu, et al. (USP 5,586,627).

The Examiner's position is that Groves, et al. includes most of the limitations of the present invention but Groves, et al. fails to include the limitation of the piston defining compression fluid passages and rebound fluid passages, the limitation of a compression valve and a rebound valve attached to the piston and the limitation that the rebound valve opens at a higher pressure than the compression valve. The Examiner then looks to Nezu, et al. to disclose a piston having compression and rebound passages, compression and rebound valves where lines 41-44 of column 40 teach that shock absorbers can be arranged such that different damping forces can be set at the extension side and the contraction side. The Examiner, in the Advisory Action mailed August 29, 2005, Paper No. 20050825, notes that Nezu, et al. teaches the use of an adjustable shock absorber that has a damping characteristic determined by the piston that is controlled by a valve assembly 66, 67 that is separate from the piston. The

Examiner goes on to say that since both devices include a piston and a separate, external valve assembly used to control the damping characteristics of the absorber, it would have been obvious to one of ordinary skill in the art to have modified the piston of Groves, et al. to have included compression and rebound passages and valves, as taught by Nezu, et al. in order to provide an alternate means of creating or determining a damping characteristic to be controlled by the separate external valve assembly. The Examiner then states that the Nezu, et al. reference itself suggests the modification of the piston of Groves, et al.

The problem with the Examiner's position is that Groves, et al. specifically teaches that the piston is not designed to create a damping force as is suggested by the Examiner in her modification of Groves, et al. by Nezu, et al. Column 4, line 64 to column 5, line 4 of Groves, et al. states that during the operation of shock absorber 10, there is no damping force characteristic that is determined by piston 12. The damping characteristic for shock absorber 10 is controlled entirely by servo valve assembly 22.

If a proposed modification or combination of the prior art (the modification of Groves, et al. with the passages and valving of Nezu, et al.) would change the principle of operation of the prior art invention being modified (the Groves, et al. shock absorber) then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Thus, modifying Groves, et al. with the passages and valving of Nezu, et al. would change the principle of operation of Groves, et al. since it would allow the piston to generate damping characteristics which goes against the teachings of Groves, et al.

When applying 35 USC § 103, the following four tenets of patent law must be adhered to.

First - The claimed invention must be considered as a whole.

Second - The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination. The Examiner's position is that Nezu, et al. suggests the modification even though Groves, et al. specifically teaches away from the combination by stating that only valve assembly 22 controls the damping force. As stated above, the teachings of the references are not sufficient to render the claims obvious if the principle of operation of the modified reference would change. Also, when Groves, et al. is taken as a whole, including disclosures that teach away from the claims, it is clear that there is no suggestion to combine the teaching of Nezu, et al. with Groves, et al. Here, the Groves, et al. reference teaches away from the claims of the present invention because Groves, et al. specifically states that no damping characteristics are generated by the piston. Thus, when Groves, et al. is taken as a whole including the disclosure that teaches away from the claimed invention there is no suggestion to combine those references.

Third – The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. Here it is clear that the Examiner

has used hindsight vision in picking and choosing isolated elements from the various pieces of prior art to render the claims of the present application obvious. Here, the Groves, et al. reference teaches away from the claims of the present invention because Groves, et al. specifically states that no damping characteristics are generated by the piston. Thus, when Groves, et al. is taken as a whole including the disclosure that teaches away from the claimed invention it is clear that the Examiner is using improper hindsight reconstruction.

Fourth - Reasonable expectation of success is the standard with which obviousness is determined.


The Examiner's final sentence in the Advisory Action states "As discussed above, it is the combination of Groves, et al. in view of Nezu, et al. that teaches the claimed invention, therefore, the references should not be attacked individually." Applicants have not attacked the references individually. Applicants have argued the combination of the references is improper because the references do not provide the suggestion of motivation to combine the references.

Thus, Applicants believe Claims 1-11 and 13-21 patentably distinguish over the art of record. Reconsideration of the rejection is respectfully requested.

Respectfully submitted,

Dated: September 8, 2005

By:

  
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